

Appln. No. 09/892,340
Amdt. dated May 23, 2005
Reply to Office Action mailed February 23, 2005

REMARKS

Applicant's attorney thanks the Examiner for the Office Action mailed February 23, 2005. By the Office Action, the Examiner has rejected Claims 1-6, 11, 13-15, 21 and 22 under 35 U.S.C. §102(b) as being anticipated by Gianturco European Patent Publication No. 0554485 (hereinafter "the Gianturco Publication"). The remaining pending claims (i.e., Claims 7-10 and 12) have been rejected under 35 U.S.C. §103(a) as being obvious over the Gianturco Publication in view of one or more secondary references (i.e., Bendavid et al. U.S. Patent No. 4,769,038 and Gonzalez International Publication No. WO 97/22310). For the reasons discussed hereinbelow, the foregoing claim rejections are respectfully traversed.

Rejection under 35 U.S.C. §102(b)

Independent Claim 1 and dependent Claims 2-6, 11, 13-15, 21 and 22 stand rejected under 35 U.S.C. §102(b) as being anticipated by the Gianturco Publication. Initially, applicant's attorney notes that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applying the foregoing legal standards, it is respectfully submitted that the Gianturco Publication fails to disclose all of the elements recited in Claim 1 and hence dependent Claims 2-6, 11,

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13-15, 21 and 22. For instance, Claim 1 recites the following element which is not disclosed or suggested by the Gianturco Publication: "said mesh layer in the location of said at least one ridge having a rigidity which is **not greater** than the rigidity of the rest of said mesh layer" (referred to hereinafter as "the 'rigidity' element"). What follows is a more detailed discussion of the Gianturco Publication and the device disclosed therein.

With reference to the Office Action, the Examiner asserts that the Gianturco Publication discloses a biocompatible circular prosthetic mesh system adapted for implantation into a body comprising a flexible mesh layer, the mesh layer having a generally flat shape when it is in a first condition and a generally collapsed shape when it is in a second condition. The Examiner also asserts that the Gianturco Publication teaches that the mesh layer has a ridge formed therein that is irremovable therewith and projecting therefrom in a direction substantially perpendicular to said mesh layer when said mesh layer is in its first flat condition. Even if it is assumed, for the sake of argument only, that the foregoing assertions are correct, the Examiner has failed to show that all of the elements of Claim 1 are taught by the Gianturco Publication. For instance, the Office Action fails to address whether the Gianturco Publication teaches the "rigidity" element of Claim 1 (i.e., "said mesh layer in the location of said at least one ridge having a rigidity which is **not greater** than the rigidity of the rest of said mesh layer"). As discussed below, applicant respectfully submits that the Gianturco Publication not only fails to disclose the "rigidity" element of Claim 1, but also teaches away from the concept of providing such an element.

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With reference to column 11, lines 1-12, the Gianturco Publication states the following:

The barrier material of the device may be a guard of flexible synthetic material, in the illustrated design a net 113 of polypropylene, mersutures or a biodegradable material such as a resorbable polyester, e.g. vicryl or resomer. The barrier material may alternatively be a thin, preferably circular piece of PTFE, e.g. gore-tex (soft tissue patch). Net 113 may be kept spread, mainly in a plane shape by a **stiffener** 114 consisting of a comparatively thin wire of the alloy Nitinol that is a shape memory alloy which at an increased temperature, e.g. at 500° C may be set in a predetermined shape. (Emphasis added).

The Gianturco Publication further teaches that the stiffener 114 retains its superelasticity and stiffness during the manipulation and insertion into the abdominal cavity. As is clear from the foregoing description, the Gianturco Publication teaches that the stiffener 114 (which is indicated in the Office Action as being equivalent to the ridge recited in Claim 1) is made of a material which is **stiffer** than the net 113 (which is indicated in the Office Action as being equivalent to the mesh layer of Claim 1). In such circumstances, applicant respectfully submits that the Gianturco Publication not only fails to disclose the "rigidity" element recited in Claim 1 (i.e., "said mesh layer in the location of said at least one ridge having a rigidity which is **not greater** than the rigidity of the rest of said mesh layer"), but also teaches away from the concept of providing a mesh layer with same.

In view of the foregoing comments, Claim 1 is believed to be patentable over the Gianturco Publication. Accordingly, applicant respectfully requests that the Examiner's rejection of Claim 1 be withdrawn.

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With respect to the Examiner's rejection of Claims 2-6, 11, 13-15, 21 and 22, all of them depend from Claim 1. In such circumstances, applicant respectfully request that the rejection of these dependent claims be withdrawn.

For the sake of good order, applicant's attorney notes that the number of the Gianturco Publication is incorrectly identified in the Office Action as EP 0554485 B1. The correct number of this publication is EP 0544485 B1. Applicant's attorney therefore requests the Notice of References Cited mailed together with the Office Action of February 23, 2005 be reissued with the correct number.

Rejection under 35 U.S.C. §103(a)

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the Gianturco Publication in view of Bendavid et al. U.S. Patent No. 4,769,038 (hereinafter "the Bendavid et al. Patent"). Moreover, Claims 8-10 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Gianturco Publication in view of the Bendavid et al. Patent and further in view of Gonzalez International Patent Publication No. WO 97/22310 (hereinafter "the Gonzalez Publication"). Since Claims 7-10 and 12 depend from Claim 1 and therefore include all of the elements recited therein, for the reasons discussed above, the Gianturco Publication does not disclose all of the elements of Claims 7-10 and 12. Moreover, the Bendavid et al. Patent and the Gonzalez Publication do not remedy the deficiency of the Gianturco Publication. Thus, Claims 7-10 and 12 are patentable over the cited references. Accordingly, applicant

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respectfully requests that the Examiner's rejections of Claims 7-10 and 12 be withdrawn.

Additional Novel Features

With respect to dependent Claims 2-15, 21 and 22, each of which depends from Claim 1, one or more of them recites additional novel features of the present invention. For instance, Claim 21 recites that the ridge of the present invention is formed monolithically with the mesh layer. The monolithically formed ridge of Claim 21 is not disclosed in or suggest by the cited references, including the Gianturco Publication, the Bendavid et al. Patent and the Gonzalez Publication. In such circumstances, it is respectfully urged that these novel features provide a further basis supporting the patentability of the present invention as recited in dependent Claims 2-15, 21 and 22.

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In view of the foregoing comments, applicant respectfully requests reconsideration and allowance of Claims 1-15, 21 and 22. Should there remain any questions or other matters whose resolution could be advanced by a telephone call, the Examiner is cordially invited to contact applicant's undersigned attorney at his number below.

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It is believed that no fees are attributable to this Amendment. Should there be any fees required as a result of this Amendment, the Examiner is authorized to charge them to Deposit Account No. 501402.

Respectfully submitted,

McCARTER & ENGLISH, LLP

A handwritten signature in black ink, appearing to read "John K. Kim", is written over the printed name.

By: John K. Kim
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